

REMARKS

Claims 1-28 are pending in the present application. Claims 1, 2 and 23 are amended herein to more clearly describe the invention. Applicants respectfully submit that no new matter is added by the current amendments.

Record of Telephonic Interview:

A telephonic interview was conducted on 13 May 2004 between Applicants' attorney, Joseph P. Quinn, Examiner Mirellys Jagan and Supervisory Patent Examiner Diego Gutierrez (hereinafter "the Examiners").

The Examiners indicated that a new affidavit should be filed to declare that the present invention antedates U.S. Patent Publication No. 2002/0181545 to Babkes. It was agreed that all of the rejections under 35 U.S.C. 102(e) should be withdrawn once a proper declaration is submitted with evidence proving that U.S. Patent Publication No. 2002/0181545 to Babkes is not available prior art.

The remainder of the interview consisted of discussions of the Examiner's rejections under 35 U.S.C. 103(a) over U.S. Patent No. 4, 619,271 to Burger, U.S. Patent No. 5,347,476 to McBean Sr. (hereinafter "McBean") and U.S. Patent No. 3,681,991 to Eberly Jr. (hereinafter "Eberly"). Applicants' attorney maintained that the rejections under 35 U.S.C. 103(a) are improper because improper hindsight would be required to find motivation to dissect and combine the references in such a way as to achieve the present invention as claimed. No agreement was reached with regard to the rejections under 35 U.S.C. 103(a). Applicants' attorney agreed to file the present written response indicating why improper hindsight would be required to combine McBean Sr. and Eberly in a way that would render the present claims obvious under 35 U.S.C. 103(a).

Rejections Under 35 U.S.C. 102(e)

The Examiner rejected claims 1-28 under 35 U.S.C. 102(e) over U.S. Patent Publication No. 2002/0181545 to Babkes (hereinafter "the Babkes '545 application"). Applicants respectfully submit that the present invention was made before the filing of the Babkes '545 application. Mitchell H. Babkes and Y. Dennis Yerlikaya were co-inventors of the present invention, which was described but not claimed in the Babkes '545 application. The present claims of Babkes and Yerlikaya cover different inventive aspects of the same device described in the Babkes '545 application, which Babkes and Yerlikaya developed while working together as employees of the common assignee. An affidavit under 37 C.F.R. 1.131 is submitted herewith including Y. Dennis Yerlikaya's declaration that the present invention antedates the '545 application and including documentary evidence in support of Mr. Yerlikaya's declaration. Applicants submit that the Babkes '545 application is therefore unavailable as a reference under 35 U.S.C. 102(e) and that each of the rejections relying on Babkes should be withdrawn.

Rejections Under 35 U.S.C. 103(a)

In light of the affidavit under 37 C.F.R. 1.131 submitted herewith, Applicants respectfully request that the Examiner withdraw each of the rejections under 35 U.S.C. 103(a), which rely on the Babkes '545 application.

The Examiner rejected claims 1-7, 9, 11, 13 and 28 under 35 U.S.C. 103 (a) over McBean in view of Eberly. Applicants respectfully disagree with the Examiner's assertion that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the removable module disclosed by McBean by adding a chamber in the module for storing the probe and a chamber in the module for storing a supply of disposable probe covers, as taught by Eberly..."

Applicants respectfully submit that Eberly does not teach or suggest a removable module of any sort. Rather, Eberly discloses an electronic thermometer that includes a probe, a probe storage chamber and a probe cover storage chamber among other typical components of an electronic thermometer such as temperature calculating components, a display, a housing, etc. Accordingly, Eberly alone does not teach or suggest the removable module of the present invention.

Applicants further respectfully submit that McBean does not teach or suggest a temperature probe storage chamber or a temperature cover storage chamber in a removable module. Rather, McBean merely discloses a generic instrumentation system with generic removable sensor modules. Accordingly, McBean alone does not teach or suggest the removable module of the present invention.

Applicants submit that the probe storage chamber in Eberly is part of the housing and that Eberly does not teach or suggest separating the probe storage chamber away from the housing to a removable module, nor does Eberly suggest any reason or advantage for doing so. Moreover, McBean does not suggest any reason for adding a probe cover storage chamber to a removable module.

It does not logically follow, as the Examiner asserts, that A) because thermometers having housings with probe cover storage chambers are known as taught by Eberly, and B) instrumentation systems having removable sensor modules are known as taught by McBean, then C) thermometers having removable sensor modules with probe cover store chambers on the module are obvious. On this basis, it is even less logical to assert that thermometers having removable sensor modules with probe cover storage chambers AND probe storage chambers on the module as claimed are obvious.

Applicants respectfully submit that it is improper for the Examiner to selectively dissect an elementary component (i.e., cover storage chamber) from one reference for combining with a completely unrelated component (i.e., sensor module) in another reference where no reason for doing so is suggested in either reference. Such selective dissection and combination of elementary components from various references certainly requires use of improper hindsight.

During the telephonic interview of 13 May 2004 with Applicants' attorney, the Examiner indicated that the motivation to combine would be available to persons of ordinary skill in the art because of the known need (solved by the present invention) to avoid cross-contamination of temperature probes. Applicants submit that knowledge of the existence of a problem in the field does not render its solution obvious. This is especially true in the present matter wherein each of the cited references are highly susceptible to the problem of cross contamination. Improper hindsight is required to look back among the references, and to pick and choose elementary components thereof which heretofore had not been combined to solve a long existing problem (i.e., to take the inventive step).


Applicants respectfully submit that each of the remaining rejections under 35 U.S.C. 103(a) rely on the improper combination of Eberly and McBean. Since none of the cited references alone or in any combination with the other cited references teach or suggest each and every element of the independent claims, the Examiner has not made out a *prima facie* case of obviousness under 35 U.S.C. 103(a). Accordingly, the rejections of claims 1-28 are improper and should be withdrawn.

In light of the foregoing remarks, Applicants request the Examiner's reconsideration and withdrawal of the rejections to claims 1-28. Applicants believe that this application is now in condition for allowance and such action at an early date is earnestly requested.

Please charge any fees or credits to deposit account No. 50-0369. Also, in the event any additional extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge deposit account No. 50-0369 therefore.

Respectfully submitted,

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